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By: _____
Patti Hespell

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of Gregory Flickinger.

Conf. No.: 5795 : Group Art Unit: 2623
Appln. No.: 09/749,255 : Examiner: Jason P. Salce
Filing Date: 27 December 2000 : Attorney Docket No.: T727-10
Title: Scheduling and Presenting IPG Ads in Conjunction with Programming Ads in a Television Environment

Request for Pre-Appeal Brief Conference

Applicant(s) request(s) review of the final rejection in the above-identified application, under the Pre-Appeal Brief Conference Program published on July 12, 2005. No amendments are being filed with this request.

- ☒ The review is requested for the reason(s) stated on the attached sheet(s).
- ☒ Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences is filed herewith.

Date: 9/19/06

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STATEMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Presently, claims 2-5, 10-12 and 28-40 are pending in the application. This paper is being filed in support of the Request for Pre-Appeal Brief Conference submitted herewith. Details of the Examiner's rejections may be found in the Final Office Action dated June 30, 2006 ("Final Office Action") and the Examiner's Non-Final Office Action dated December 19, 2005 ("Non-Final Office Action"). Discussion of the prior art references and the pending claims may be found in Applicant's Amendment filed March 17, 2006 ("Amendment") and Applicant's Amendment Accompanying RCE filed September 30, 2005 ("Amendment Accompanying RCE"), both of which are incorporated herein by reference.

No Prima Facie Case of Obviousness

Even though the Examiner has not established a *prima facie* case for obviousness, the Examiner has not withdrawn the rejection of claims 1, 2, 9, 11-14, 16-20, 21, 31-35, and 37-38 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,177,931 to Alexander *et al.* ("Alexander") in view of U.S. Patent No. 6,002,393 to Hite *et al.* ("Hite"). Applicant maintains that Alexander and Hite are not properly combinable and even if combined, such combination does not teach all aspects of the claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references, when combined) must teach or suggest all of the claim limitations. See MPEP 2143.

1. There is No Motivation to Combine Alexander and Hite

There is no motivation to combine Alexander and Hite, since Alexander teaches showing a particular ad window and PIP window combination based on the item in the EPG that is currently selected (column 19, lines 13-37), while Hite teaches away from Alexander and suggests showing a particular programming ad based on the profile of the user as stored in the “Consumer Database” (column 7, lines 20-29). See pages 12-13 of the Amendment for further explanation of the lack of motivation to combine.

In dismissing Applicants’ arguments concerning the motivation to combine the references, the Examiner has selectively considered the queue taught by Hite and ignored the context in which the queue functions. The Examiner has seemingly ignored the “Basic Considerations Which Apply to Obviousness Rejections,” that instruct the Examiner that “[t]he references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination,” (see MPEP 2141). Further, MPEP 2141.02 instructs that “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.”

Therefore, removing the queue from the other teachings of Hite and ignoring the context in which the queue functions is improper. Previously, Applicant requested that the Examiner consider the context surrounding Hite’s queue (see Amendment, pages 12-14), since, it appeared as though the Examiner did not consider Hite “as a whole.” Instead, the Examiner decided that “[t]he only teaching used from Hite is that a queue can be used to store EPG ads,” (Final Office Action, page 5) and that the differences in the teachings of the references need not be evaluated. Since the Examiner has not considered the whole of Hite, Applicants’ arguments concerning the motivation to combine the references have not been properly considered. Furthermore, since the Examiner has not provided a proper motivation to combine Alexander and Hite, the Examiner has not satisfied the burden of *prima facie* obviousness. Moreover, there is no motivation to combine Alexander and Hite, because Hite teaches away from Alexander.

2. The Proposed Combination Changes the Mode of Operation of the Primary Reference

Even if Alexander and Hite are combined as suggested by the Examiner, the inclusion of Hite's features would change the mode of operation of Alexander. More specifically, Hite would change the mode of operation of Alexander in respect to choosing what item to display. Alexander discloses linking items in the EPG to other items in the EPG and choosing what item to display based on the link between the items. Hite discloses displaying programming ads based on the user's profile. If Alexander were to choose what ad to display based on the user profile instead of based on the link, this would substantially change Alexander's mode of operation and the basic premise on which Alexander functions. Similar to the Examiner's analysis of the motivation to combine, the Examiner has not considered Hite "as a whole, including portions that would lead away from the claimed invention." Therefore, Applicant maintains that the combination of the references would change the mode of operation of the primary reference and that Applicant's arguments have not been fully considered. See page 14 of the Amendment for further explanation of the lack of motivation to combine.

3. Alexander in View of Hite Does Not Disclose All Elements of the Claims

Even if the references are properly combinable, Alexander in view of Hite does not teach all elements of the Applicant's claims (see Amendment Accompanying RCE, page 7, and Amendment, Page 7). In particular, Alexander in view of Hite does not teach or suggest either an "IPG ad queue containing an ordered list of IPG ads," displaying IPG ads "wherein the IPG ads are displayed in accordance with the IPG ad queue," or "reordering the IPG ads queue in accordance with the displayed programming ad," as recited in independent claim 28.

The Examiner has refused to acknowledge that the teachings of Alexander in view of Hite do not teach "reordering the IPG ad queue in accordance with the displayed programming ad." Alexander cannot teach the reordering of a queue because according to the Examiner, Alexander does not teach "the specific memory structure of a queue to store the IPG and programming ads..." (see Non-Final Office Action, page 4). Alexander does teach that ads can rotate, that ads may be assigned a priority, that the highest priority ad is displayed the first time a page is

accessed, that the second highest priority ad is displayed the second time the page is accessed (etc.), and that the EPG may be timed to display a correlative ad to the ad that was being shown on the channel. However, a reference cannot teach how to reorder a data structure in the absence of that data structure. As previously explained, a rotation of items is not the same as the reordering of a queue. The disclosure of Alexander does not provide a way to reorder a queue (nor does Hite provide for a way to reorder the queue), and therefore the combination of the references does not teach the “reordering the IPG ad queue in accordance with the displayed programming ad.”

The Examiner argues that reordering the IPG ads may be separated from their connection to the queue. Therefore, the Examiner concludes that Alexander teaches reordering IPG ads. Applicant submits that as previously stated, reordering of an IPG ad queue cannot be taught in the absence of the queue. However, even if it can, Alexander does not teach reordering IPG ads. The Examiner argues that because “different ads can appear each time the user enters the same page/section of the Guide,” that this is equivalent to the reordering recited in independent claim 28. Instead, such a teaching is what Alexander itself labels: “rotation,” (see column 26, lines 45-48) - not reordering. The Examiner also argues that displaying an ad correlative to the ad that was being shown on the channel at the time the viewer entered the EPG is equivalent to the reordering of claim 28. The display of an ad that correlates the ad that was being shown on the channel at the time the viewer entered the EPG is also not the same as “reordering the IPG ad queue in accordance with the displayed programming ad,” nor is it equivalent to reordering IPG ads stored in memory. Alexander does not teach how the display of an ad that correlates with the ad that was being shown on the channel at the time the viewer entered the EPG constitutes a reordering of IPG ads. Accessing an IPG ad in memory based on a correlation between the IPG ad and the ad shown on the channel and displaying the IPG ad does not change the order in which the IPG ad or other IPG ads are stored. Thus, the Examiner’s argument that accessing RAM in order to retrieve an IPG ad for display teaches the reordering aspect of independent claim 28 is incorrect. Therefore, Alexander does not teach reordering IPG ads and certainly does not teach reordering the IPG ad queue in accordance with the displayed programming ad” as recited in claim 28.

Further, the Examiner has refused to acknowledge that Alexander does not teach “storing IPG ads..., the IPG ads being stored in an ordered list” (see page 3 of the Non-Final Office Action). The Examiner argues that column 5, lines 13-15 of Alexander teach an ordered list, while Applicant maintains that it does not (see Amendment, page 8). The Examiner claims this list is at least in a “random order,” (see Final Office Action, page 2). However, the words “[m]ore than one virtual channel ads may be stored in RAM, but preferably only one such ad is display at a time,” do not teach or suggest an ordered list. Further, Applicant maintains that items stored in a “random order” are not ordered within the meaning of claim 28 as the Examiner argues. The Examiner admits that Alexander is silent to what type of order the ads are stored in, (Final Office Action, page 2). In the absence of a teaching of some type of order, Alexander cannot teach an ordered list (see Amendment, page 9).

In light of the fact that Alexander in view of Hite does not teach or suggest all of the features of independent claim 28, there is no motivation to combine the references, and doing so would change the mode of operation of the primary reference, the Examiner has not met the burden of establishing a prima facie case for obviousness. Accordingly, for the reasons detailed herein as well as in Applicant’s Amendment and Amendment Accompanying RCE, independent claim 28, independent claim 31, and all claims dependent thereon, are allowable over Alexander in view of Hite.

Applicant respectfully submits that the Examiner’s rejections have been previously overcome, and that the application, including claims 2-5, 10-12 and 28-40, is in condition for allowance. Reconsideration and withdrawal of the Examiner’s rejections and a Notice of Allowance are respectfully requested.